UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,777	06/25/2003	Scott A. Moskowitz	80391.0003	2233

7590 11/06/2006	**EXAMINER**
SCOTT A MOSKOWITZ	LASHLEY, LAUREL L
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#2505	ART UNIT	PAPER NUMBER
MIAMI, FL 33160	2132	

DATE MAILED: 11/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>25 June 2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>6-24,30 and 31</u> is/are pending in the application.

    4a) Of the above claim(s) <u>22-24</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>6-21,30-31</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

Election/Restrictions

1.   Restriction to one of the following inventions is required under 35 U.S.C. 121:

    I.   Claims 6 – 21 and 30 - 31, drawn to a method for manipulating file format

information, classified in class 713, subclass 176.

    II.   Claims 22 - 24, drawn to a method for mask sets to be used for encoding,

classified in class 380, subclass 205.

2.   Inventions I and II are related as subcombinations disclosed as usable together in a

single combination. The subcombinations are distinct if they do not overlap in scope and are

not obvious variants, and if it is shown that at least one subcombination is separately usable. In

the instant case, Invention I has separate utility such as manipulating file format information.

Invention II has separate utility such as for encoding stream data. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where

applicant elects a subcombination and claims thereto are subsequently found allowable, any

claim(s) depending from or otherwise requiring all the limitations of the allowable

subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP

§ 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional

application is anticipated by, or includes all the limitations of, a claim that is allowable in the

present application, such claim may be subject to provisional statutory and/or nonstatutory

double patenting rejections over the claims of the instant application.

3.   Because these inventions are independent or distinct for the reasons given above and

there would be a serious burden on the examiner if restriction is not required because the

inventions have acquired a separate status in the art in view of their different classification,

restriction for examination purposes as indicated is proper.

4.   Because these inventions are independent or distinct for the reasons given above and
there would be a serious burden on the examiner if restriction is not required because the
inventions require a different field of search (see MPEP § 808.02), restriction for examination
purposes as indicated is proper.

5.   Because these inventions are independent or distinct for the reasons given above and
there would be a serious burden on the examiner if restriction is not required because the
inventions have acquired a separate status in the art due to their recognized divergent subject
matter, restriction for examination purposes as indicated is proper.

6.   Applicant is advised that the reply to this requirement to be complete must include (i) an
election of a species or invention to be examined even though the requirement be traversed (37
CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

        The election of an invention or species may be made with or without traverse. To
reserve a right to petition, the election must be made with traverse. If the reply does not
distinctly and specifically point out supposed errors in the restriction requirement, the election
shall be treated as an election without traverse.

        Should applicant traverse on the ground that the inventions or species are not patentably
distinct, applicant should submit evidence or identify such evidence now of record showing the
inventions or species to be obvious variants or clearly admit on the record that this is the case.
In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the
evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

7.   During a telephone conversation with Scott Moskowitz on 12 October 2006 a provisional
election was made with traverse to prosecute the invention of Group I, claims 6 – 21 and 30 -
31. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 22 – 24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as

being drawn to a non-elected invention.

8.   Therefore, claims 6 – 21 and 30 – 31 have been examined.

Claim Objections

9.   Claim 14 is objected to under 37 CFR 1.75(c), as being of improper dependent form for

failing to further limit the subject matter of claim 6. Applicant is required to cancel the claim, or

amend the claim to place the claim in proper dependent form, or rewrite the claim in

independent form. Since claim 14 is identical in language and functionality to claim 13, it does

not constitute a further limitation of claim 6.

10.   Claims 19 is objected to because of the following informalities:

- Recitation of "secure way hash function" where it should be --secure one way

  hash function--;

- Recitation of "has" where it should be --hash--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

11.   Claims 19 and 30 – 31 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Claim 19 recites the limitation "the has[h] function", "the carrier signal" and "file format".

There is insufficient antecedent basis for these limitations in the claim.

Claim 30 recites the limitation "the digital data signal". There is insufficient antecedent

basis for this limitation in the claim. As a result, Claim 31 is rejected by virtue of dependency on

claim 30.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the
United States before the invention thereof by the applicant for patent, or on an international application
by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this
title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of

1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of

2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA

35 U.S.C. 102(e)).

12.   Claims 6 – 21 and 30 – 31 are rejected under 35 U.S.C. 102(e) as being anticipated by

Borgelt et al. in US Patent No. 5398285 (hereinafter US '285).

13.   As for Claim 6, US '285 discloses:

A method for protecting a digital signal, comprising the steps of:

        providing a digital signal comprising digital data and a file format information;

        creating a predetermined key that manipulates the file format information; and

        manipulating the file format information using the predetermined key. (see Abstract;

Figure 2; column 4,line 5 – column 5, lines 1 – 43: software program equivalent to digital signal,

embedded software code equivalent to digital data, unique identification code equivalent to file

format information, private key is equivalent to predetermined key)

For claim 7, US '285 discloses:

The method of claim 6, wherein the digital signal represents a continuous analog waveform.

(see column 3, lines 29 –31)

For claim 8, US '285 teaches:

The method of claim 6, wherein the predetermined key comprises a plurality of mask sets. (see

column 3, lines 58 – 63)

For claim 9, US '285 teaches:

The method of claim 6, wherein the digital signal is a message to be authenticated. (see column

5, lines 14 – 20)

For claim 10, US '285 teaches:

The method of claim 6, wherein the predetermined key comprises a key pair comprising a

public key and a private key. (see column 2, lines 24 – 26)

For claim 11, US '285 teaches:

The method of claim 6, further comprising the step of:

using a digital watermarking technique to encode information that identifies

ownership, use, or other information about the digital signal, into the digital signal. (see column

2, lines 7 – 11; column 3, lines 10 – 13)

For claim 12, US '285 teaches:

The method of claim 6, wherein the digital signal represents a still image, audio or video. (see

column 3, lines 20 – 22 and 27 – 31)

For claims 13 and 14, US '285 teaches:

The method of claim 6, wherein the predetermined key comprises one or more mask sets

having random or pseudo-random series of bits, the method further comprising the steps of:

      validating the one or more mask sets before manipulating the file format information

using the predetermined key. (see column 3, lines 58 – 63)

      For claim 15, US '285 teaches:

The method of claim 6, wherein the predetermined key comprises one or more mask sets

having random or pseudo-random series of bits, the method further comprising the steps of:

      generating a hash value using the one or more masks sets; and

      authenticating the one or more mask sets by comparing the generated hash value with a

hash value. (see column 5, lines 2- 13)

      For claim 16, US '285 teaches:

The method of claim 13, wherein said step of validating comprises the steps of:

      generating a digital signature using the one or more mask sets; and

      comparing the digital signature with a predetermined digital signature. (see column 2,

lines 56 - 60)

      For claim 17, US '285 teaches:

The method of claim 6, wherein the predetermined key comprises one or more mask sets

having random or pseudo-random series of bits, the method further comprising the steps

of:

      authenticating the one or more mask sets by comparing a generated digital signature

with a predetermined digital signature.(see column 2, line 56 – column 3, lines 1 – 6)

      For claim 18, US '285 teaches:

The method of claim 13, further comprising the step of:

using a digital watermarking technique to embed information that identifies ownership,

use, or other information about the digital signal, into the digital signal; and

wherein said step of validating is dependent on validation of the embedded information.

(see column 2, lines 7 – 11; column 5, lines 2 – 10)

For claim 19, US '285 teaches:

The method of claim 6, further comprising the step of:

computing a secure way hash function of carrier signal data in the digital signal,

wherein the has function is insensitive to changes introduced into the carrier signal during file

format manipulation. (see column 2, line 56 – column 3, lines 1 – 6)

For claim 20, US '285 teaches:

A method for protecting a digital signal, comprising the steps of:

providing a digital signal comprising digital data and file format information;

creating a predetermined key comprising a mask set;

manipulating the file format information using the predetermined key;

authenticating the predetermined key during playback of the digital data; and

metering the playback of the digital data to monitor content. (see Abstract; Figure 2;

column 4,line 5 – column 5, lines 1 – 43)

For claim 21, US '285 teaches:

The method of claim 20, wherein the predetermined key is authenticated to authenticate

message information. (see column 5, lines 14 – 20)

For claim 30, US '285 teaches:

A method for protecting digital data, where the digital data signal is organized into a plurality of

frames, each frame having i) a header comprising file format information and ii) at least a

portion of the digital data, said method comprising the steps of:

creating a predetermined key to manipulate the file format information in one or more of the plurality of frames; and

manipulating the file format information using the predetermined key in at least two of the plurality of frames, such that the digital data will be perceived by a human as noticeably altered if it is played without using a decode key to restore the file format information to a prior state. (see Abstract; Figure 2; column 4,line 5 – column 5, lines 1 – 43)

For claim 31, US '285 teaches:

The method of claim 30, wherein the predetermined key comprises a private key that is associated with a key pair. (see column 2, lines 24 – 26)

Conclusion

14.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Morris in US Patent No. 5530751 discloses embedded hidden identification code in digital objects.

15.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurel Lashley whose telephone number is 571-272-0693. The examiner can normally be reached on Monday - Thursday, alt Fridays btw 7:30 am & 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron, Jr. can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private

PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you

would like assistance from a USPTO Customer Service Representative or access to the

automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Laurel Lashley
Examiner
Art Unit 2132

31 October 2006
LLL

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